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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO.              |
|---|-------------|----------------------|---------------------|-------------------------------|
| 10/813,901  | 03/30/2004  | Berna Erol           | 015358-010000US     | 5028                          |
| 20350   | 7590        | 05/31/2006           |                     |                               |
| TOWNSEND AND TOWNSEND AND CREW, LLP<br>TWO EMBARCADERO CENTER<br>EIGHTH FLOOR<br>SAN FRANCISCO, CA 94111-3834 |             |                      |                     | EXAMINER<br>SAIN, GAUTAM      |
|   |             |                      |                     | ART UNIT<br>2176 PAPER NUMBER |

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|------------------------------|------------------------|---------------------|--|
|                              | 10/813,901             | EROL ET AL.         |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Gautam Sain            | 2176                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 30 March 2004.

2a)  This action is FINAL.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-69 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-69 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/04.

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_ .

## DETAILED ACTION

- 1) This is a Nonfinal rejection in response to application filed on March 30, 2004.
- 2) Claims 1-69 are pending.
- 3) Effective filing date is 3/30/2004.

### ***Claim Rejections - 35 USC § 101***

- 4) 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-69 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-69 set forth non-functional descriptive material but fail to set forth physical structures or materials comprising of hardware or a combination of hardware and software within the technological arts (ie., a computer) to produce a “useful, concrete and tangible” result. For example, independent claims 1, 21, 34, 44, 51, 61, 68 and 69, the “method”, “product” and “process reads on a mental construct/abstract idea or at best a computer program, per se. The language such as “electronic representation”, etc, does not clearly define structural elements and are not tangibly embodied on a computer readable medium. Claims 1-69 are interpreted as software per se, abstract ideas or mental construct and not tangibly embodied on a computer readable medium or hardware.

***Claim Rejections - 35 USC § 112***

5) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5-1) Claim 9, 29, 39, 49, 56 and 66 recites the limitation "the created composite electronic document" in claims 9, 29, 39, 49, 56 and 66. There is insufficient antecedent basis for this limitation in the claim. There is no prior creation of a document that is composite and electronic.

***Claim Rejections - 35 USC § 103***

6) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6-1) **Claims 1-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iron et al (US 20020111960, published on Aug 15, 2002).**

**Regarding independent claims 1, 21, 34, 44, 51, 61, 68 and 69,** Irons teaches *receiving an electronic representation of a document; extracting a feature from the electronic representation of the document; comparing the feature to the recorded information to determine information in the recorded information that matches the feature; and determining information to insert based on the information in the recorded information that matches the feature and the received electronic representation of a document.* Irons discloses a method for simultaneously managing paper-based documents and digital images of the same, simultaneously (Abstract section), where a

unique global identifier is affixed directly on the document (para 39). The process involves scanning the paper document to create a digital image of document, extracting the global unique identifier from the digital image of the label (page 4, paragraph 39), which allows indexing for storage and future retrieval processes (para 40). Since the two global unique identifiers match, the identifier is used to effectively link the document image to the record in the database, facilitating later retrieval of the document image, via the index (para 48).

Iron does not expressly teach *creating a composite electronic representation comprising the determined information*, but Iron does suggest it based on its disclosure. Iron discloses the paper document linked to the imaged document and joined by the globally unique identifier which can be the file name or the basis for creating the file name used in naming the digital image of the paper-based document, thereby linking the paper-based document and the subsequently created digital image of the paper-based document (para 49). The Examiner interprets this linking as equivalent to a composite electronic representation.

It would have been obvious to one of ordinary skill in the art at the time of the invention to interpret Irons' disclosure of paper document linked to the imaged document and joined by the globally unique identifier which can be the file name or the basis for creating the file name used in naming the digital image of the paper-based document as equivalent to the claimed composite electronic representation, providing the benefit of allowing a user to quickly and easily gain access to the electronic images

of paper-based documents (para 50) and simultaneously managing the linked paper documents (Abstract section).

**Regarding claims 2, 22, 35, 45 and 52,** Irons teaches determining association information for the recorded information that matches the feature. Irons discloses, linking the document image to the record in the database by matching the two global unique identifiers, facilitating later retrieval of the document image, via the index (para 48).

**Regarding claims 3, 23, 46 and 63,** Irons teaches association information including source information for the recorded information. Irons discloses attaching a global unique identifier to the paper document with an adhesive backed label, indexing the digital image of the paper document based on the information captured prior to the imaging and the image is linked to the physical document by the identifier (para 20). The examiner interprets the identifier as describing the source of the image, namely the linked paper document. Additionally, other descriptive information is used to identify the document (author)(para 48). The date is provided as descriptive information for the document (para 48), which the examiner interprets as time information because date is a temporal description.

**Regarding claims 4, 36 and 53,** Irons teaches associating the associating the association information with the determined information in the composite electronic representation. Irons discloses the paper document linked to the imaged document and joined by the globally unique identifier which can be the file name or the basis for creating the file name used in naming the digital image of the paper-based document,

thereby linking the paper-based document and the subsequently created digital image of the paper-based document (para 49).

**Regarding claims 5, 24, 37, 47, 54 and 64**, Irons teaches receiving a selection of the determined information in the composite electronic representation; and using the association information for the determined information to access recorded information. Irons discloses selectively retrieving either or both the paper based document and/or a digital image of the paper-based document, based on the information captured prior to the image operation (ie., using the globally unique identifier as the basis for the file name of the image linked to the record in the image database)(para 20, para 49).

**Regarding claims 6, 25, 38 and 55**, Irons teaches accessing recorded information using the determined information. Irons discloses selectively retrieving either or both the paper based document and/or a digital image of the paper-based document, based on the information captured prior to the image operation (ie., using the globally unique identifier as the basis for the file name of the image linked to the record in the image database)(para 20, para 49).

**Regarding claims 7 and 26**, Irons teaches displaying the accessed recorded information. Irons discloses retrieving the digital image with a web browser on the user interface and then displays the image (para 89).

**Regarding claims 8 and 27**, Irons teaches playing the accessed information. Examiner interprets playing as equivalent to displaying. Irons discloses retrieving the digital image with a web browser on the user interface and then displays the image (para 89).

**Regarding claims 9, 29, 39, 49, 56 and 66**, Irons discloses storing the created composite electronic document. Irons discloses generating a bit mapped image for processing the image of the paper-based document (para 85).

**Regarding claims 10, 28, 40, 48, 57 and 65**, Irons teaches determining metadata using the recorded information that matches the one or more features, wherein the composite electronic representation includes the metadata. Irons discloses a unique identifier that will be the file name used in naming the digital image of the paper-base document which links the paper-based document (para 49; para 47 specifically teaches meta-data).

**Regarding claims 11, 41 and 58**, Irons teaches received electronic representation of the paper document includes notes taken by a user, wherein the created composite electronic representation includes the notes taken by the user.

**Regarding claims 12**, Irons teaches determining the feature in one or more feature in the image; and extracting the feature. Irons discloses where an image of the paper-based document is used to generate a bit mapped image and the bit map is searched for data blocks which are the candidates for the bar codes which are used to determine the content of each unique object (para 85).

**Regarding claim 13**, Irons teaches determining a document that includes the recorded information using the extracted one or more feature. Irons discloses where an image of the paper-based document is used to generate a bit mapped image and the bit map is searched for data blocks which are the candidates for the bar codes which are used to determine the content of each unique object (para 85).

**Regarding claims 14 and 62**, Irons teaches determining a portion of the document that includes the information that matches the one or more features. Irons discloses where an image of the paper-based document is used to generate a bit mapped image and the bit map is searched for data blocks which are the candidates for the bar codes which are used to determine the content of each unique object (para 85).

**Regarding claims 15, 31, 42 and 59**, Irons teaches an identifier to a location in the recorded information, wherein the information in the recorded information that matches the feature is determined using the identifier. Irons discloses where an image of the paper-based document is used to generate a bit mapped image and the bit map is searched for data blocks which are the candidates for the bar codes which are used to determine the content of each unique object. Each of the blocks are processed to determine the content of each unique object within the data block (para 85).

**Regarding claims 16 and 32**, Irons teaches identifier comprises of a barcode. Irons discloses where an image of the paper-based document is used to generate a bit mapped image and the bit map is searched for data blocks which are the candidates for the bar codes which are used to determine the content of each unique object (para 85).

**Regarding claim 17**, Irons teaches receiving a scan of the paper document. Irons discloses a document imaging systems which can scan paper-based documents and store/retrieve the resulting electronic images (para 11).

**Regarding claim 18**, Irons teaches determining an electronic image of the paper document. Irons discloses a document imaging systems which can scan paper-based documents and store/retrieve the resulting electronic images (para 11).

**Regarding claims 19 and 33**, Irons teaches receiving the electronic representation in response to an input from a user indicating that the composite electronic representation should be created. Irons discloses a user indexing and label a document prior to scanning/imaging and then using the standard imaging equipment to create digital images of the paper-based documents (para 20).

**Regarding claims 20, 30, 43, 60, 67 and 50**, Irons teaches paper document. Irons discloses transforming paper-based documents into digital images of the paper document (para 20).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gautam Sain whose telephone number is 571-272-4096. The examiner can normally be reached on M-F 9-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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